REMARKS

The present Request for Reconsideration is in response to the Examiner's Final Office Action mailed February 1, 2005. Claims 1-49 are now pending. Reconsideration of the claims in view of the following remarks is respectfully requested. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. §102(e)

The outstanding office action rejects claims 1-3, 20, 27, 31, 32, 41 and 43 under 35 U.S.C. § 102(e) as being anticipated by *Dobberpuhl et al.* (United States Patent No. 6,754,718 B1).[1] Because *Dobberpuhl et al.* does not teach or suggest each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

Dobberpuhl et al. teaches a computer program product and method for providing access to "host attributes" in a storage area network. (*See* col. 1, lines 52-54). Such host attributes constitute information concerning a host device connected within the SAN and may include, for example, the user selected name for the host, the Internet Protocol address for the host, the operating system of the host, the type of each initiator connected to the host, and an identifier of

[1] Because *Dobberpuhl et al.* is only citable under 35 U.S.C. § 102(e), Applicants do not admit that *Dobberpuhl et al* is in fact prior art to the claimed invention but reserve the right to swear behind *Dobberpuhl et al* if necessary to remove it as a reference.

each initiator coupled to the host, such as a worldwide name. (Col. 1, lines 56-61). The host device polls for this host attribute information, and then stores the information in an addressable memory location. (Col. 1, line 64). This polling function is accomplished using a "push application" that resides on each server in the SAN. The push application obtains host attribute information and then causes the host attribute information to be "pushed" down from the server to the storage arrays in the SAN – or "targets.". (Col. 3, lines 53-57). After the host attribute information is stored for all hosts, any host may access any of the targets, and then request and retrieve the host attribute information resident on the target. (Col. 4, lines 1-7). Based upon the host attribute information retrieved, the retrieving host reconstructs the existing topology of the storage area network. (Col. 4, lines 1-7). A user may access either the topology created by the host or initiate the retrieval from a database on the target in order to create a topology which can then be displayed to a remotely connected user. (Col. 5, lines 16-23). Thus, the end result of *Dobberpuhl* is the ability to graphically display a topology of an existing SAN: the name of each server, its host bus adapters, and all of the existing data paths between the host and the storage arrays. The focus and scope of the disclosure of *Dobberpuhl* only includes displaying an existing topology of a SAN, including the existing data paths within the SAN.

The functionality of *Dobberpuhl* is in direct contrast to the presently claimed invention, which pertains to the creation of a new data path within a SAN based on a prescribed set of characteristics or attributes. For example, independent claim 1 recites the following:

> 1. A method of creating a data path for a process executing on a server coupled to a storage area network (SAN), the SAN providing connectivity between the server and a storage device in the SAN, the method comprising:
>
> parameterizing a set of attributes for a desired data path between the process and the storage device of the SAN; and
>
> constructing the data path that provides said set of attributes.

It is well established that to anticipate a claim, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); *see also* MPEP 2131. *Dobberpuhl* does not anticipate independent claim 1 at least for the reason that *Dobberpuhl* does not disclose the acts of parameterizing a set of attributes of a desired data path nor constructing the data path that provides the set of

attributes. *Dobberpuhl* merely discloses creating a topology of existing coupled servers, that can then be displayed using a graphical user interface. (*See* col. 3, lines 30-67 and Figure 1). This distinction alone demonstrates the patentable difference between the invention of claim 1 and the teachings of *Dobberpuhl.* Thus, Applicants respectfully request that the rejection of independent claim 1 be withdrawn at least for the reason that *Dobberpuhl* does not teach the identical invention in as complete detail as contained in independent claim 1.

Rejected independent claim 20 is also in direct contrast to the teachings of *Dobberpuhl.* Claim 20 as currently presented recites the following:

> 20. Apparatus for creating a data path for a process executing on a server coupled to a storage area network (SAN), the SAN providing connectivity between the server and a storage device in the SAN. the method comprising:
> means for parameterizing a set of attributes for a desired data path between the process and a storage device of the SAN; and
> means, coupled to said parameterizing means, for constructing the data path that provides said set of attributes.

Dobberpuhl does not anticipate independent claim 20 at least for the reason that *Dobberpuhl* does not disclose means for parameterizing a set of attributes for a desired data path. Nor does *Dobberpuhl* disclose means for constructing the data path that exhibits the characteristics provided or dictated by the set of attributes. Moreover, *Dobberpuhl* does not disclose apparatus for creating a data path. Thus, the Applicant's respectfully request that the rejection of independent claim 20 be withdrawn at least for the reason that *Dobberpuhl* does not teach the identical invention in as complete detail as contained in independent claim 20. Since *Dobberpuhl et al.* does not teach the each element of claims 1 and 20, Applicants respectfully request that the rejection of independent claims 1 and 20 under 35 U.S.C. § 102(e) be withdrawn.

Applicants also request that the rejection of claims 2-3, 27, 31, 32, 41 and 43 be withdrawn at least due to their dependency on an allowable base claim. Dependant claims incorporate all the limitations of the independent base claim from which they depend. Therefore, Applicant's respectfully request the rejection of claims 2-3, 27, 31, 32, 41 and 43 be withdrawn for at least the reasons set forth above in connection with the corresponding independent claims.

B. Rejection Under 35 U.S.C. § 103

The outstanding office action rejects claims 4, 5 and 18 under 35 U.S.C. § 103 as being unpatentable over *Dobberpuhl et al.* (United States Patent No. 6,754,718 B1) in view of *Wang et al.* (U.S. Patent No. 6,834,326 B1). The Applicants respectfully request that the rejection of claims 4, 5 and 18 under 35 U.S.C. § 103 be withdrawn because *Dobberpuhl* in combination with *Wang* does not teach, suggest, nor make obvious every element of claims 4, 5, and 18.

A claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (1994); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. The first step in the *Graham* inquiry requires that the PTO determine the scope and content of the prior art including what each piece of prior art teaches explicitly and inherently. MPEP 2141. The prior art reference (or references when combined) must teach or suggest all the claim limitations to establish a *prima facie* case of obviousness. MPEP 2143.

Claims 4, 5, and 18 are dependant claims incorporating every limitation of independent claim 1. As discussed above, *Dobberpuhl* does not disclose several elements of independent claim 1 in direct contrast to that asserted by the outstanding office action. Thus, to the extent that the rejection relies upon the teachings of *Dobberpuhl,* then the Examiner has failed to state a *prima facie* case of obviousness. Moreover, *Wang* does not teach or suggest the elements missing from *Dobberpuhl.* Applicants respectfully request that the rejection of dependant claims 4, 5 and 18 under 35 U.S.C. § 103 be withdrawn at least for the reason that the combination of *Dobberpuhl* and *Wang* does not teach or suggest each element of claims 4, 5 and 18.

The Examiner rejects claims 6-11, 15-17, 19, 21-26, 28-30, 33-40, 42 and 44-49 under 35 U.S.C. § 103 as being unpatentable over *Dobberpuhl et al.* (United States Patent No. 6,754,718 B1) in view of *Cheng et al.* (U.S. Patent No. 6,823,477 B1). Claims 6-11, 15-17, 21, 22, 44, and 47 are dependant claims incorporating every limitation of independent claim 1. Similarly, claims 25-26, 29, 39-40, 46, and 49 are dependant claims incorporating every limitation of independent claim 20. As discussed above, *Dobberpuhl* does not disclose or suggest several elements of

independent claims 1 and 20 in direct contrast to that asserted by the outstanding office action. Thus, because claims 6-11, 15-17, 21, 22, 25-26, 29, 39-40, 44, 46, and 47 incorporate every limitation of either independent claim 1 or independent claim 20 from which they depend, a *prima facie* case of obviousness has not been established by the outstanding office action. Because neither *Dobberpuhl* nor *Cheng* teach nor suggest all the elements of claims 6-11, 15-17, 21, 22, 25-26, 29, 39-40, 44, 46, and 47 and the Applicants respectfully request that the rejection of those claims under 35 U.S.C. § 103 be withdrawn.

Regarding independent claim 19, the Applicants respectfully request that the rejection of claim 19 under 35 U.S.C. § 103 be withdrawn because the combination of *Dobberpuhl et al.* with *Cheng* does not teach or suggest every element of claim 19 as asserted in the outstanding office action. Again, to the extent that the rejection relies upon the teachings of *Dobberpuhl*, the Examiner has not stated a *prima facie* case of obviousness, and the rejection of this claim should be withdrawn for at least the reasons previously discussed. Moreover, *Cheng* does not make up for the deficiencies of *Dobberpuhl*. *Cheng* describes a segregated user interface including a user interface having a front end graphical user interface and a backend object module to provide functionality to the interface. (*See* Col. 2, lines 33-36).

Independent claim 19 as currently presented recites the following:

> 19. A method of configuring a SAN, the SAN providing connectivity between a server and a storage device in the SAN. the method comprising:
>
> discovering, by use of an external data path engine coupled to the SAN, processes that are operable on a server coupled to the SAN;
>
> discovering, by use of said external data path engine coupled to the SAN, storage devices that are included in the SAN;
>
> responding, by use of said external data path engine coupled to the SAN, to a data path construction request from a user by providing said user with an interface to accept a set of attributes for a desired data path for one of said discovered processes; and
>
> constructing, by use of the external data path engine coupled to the SAN, the data path that provides said set of attributes.

A *prima facie* case of obviousness has not been made since the combination of *Cheng* with *Dobberpuhl* does not teach, suggest, nor make obvious every element of Claim 19. Neither

Cheng nor *Dobberpuhl* disclose responding, by use of an external path engine coupled to a SAN, to a data path construction request from a user by providing the user with an interface to accept a set of attributes for a desired data path for one of the discovered processes. In addition, neither *Cheng* nor *Dobberpuhl* disclose constructing, by use of the external data path engine coupled to the SAN, the data path that provides the set of attributes. Rather *Cheng* merely discloses the interaction of providing the user access to settings and information concerning the system and network. (Col. 8, lines 50-53). As discussed above, *Dobberpuhl* merely discloses the interaction of creating a topology of existing coupled servers that can then be displayed using a graphical user interface. (*See* col. 3, lines 30-67 and Figure 1). Therefore, the combination of *Dobberpuhl* with *Cheng* does not teach or suggest every element of independent claim 19 in contrast to that asserted in the outstanding office action. Because the combination of *Cheng* with *Dobberpuhl* does not teach or suggest every element of independent claim 19 as asserted in the outstanding office action, the Applicants respectfully request that the rejection of independent claim 19 under 35 U.S.C. § 103 be withdrawn.

Claims 23-24, 28, 30, 33-38, 42, 45, and 48 are dependant claims incorporating every limitation of independent claim 19. As discussed above, *Dobberpuhl* in combination with *Cheng* do not disclose or suggest several elements of independent claim 19. Thus, because claims 23-24, 28, 30, 33-38, 42, 45, and 48 incorporate every limitation of independent claim 19 from which they depend, a *prima facie* case of obviousness has not been established by the outstanding office action and the Applicants respectfully request that the rejection of these claims be withdrawn.

The outstanding office action rejects claims 12-14 under 35 U.S.C. § 103 as being unpatentable over *Dobberpuhl et al.* (United States Patent No. 6,754,718 B1) in view of *Cheng et al.* (U.S. Patent No. 6,824,477 B1) as applied to claim 9 in the outstanding office action and further in view of *Wang et al.* (U.S. Patent No. 6,834,326). Claim 9 is dependant upon claim 1, which is allowable over *Dobberpuhl* as described above. To the extent that the rejection relies upon the teachings of *Doberpuhl,* then the Examiner fails to state a *prima facie* case of obviousness. Because claims 12-14 are dependant upon claim 1 and as a result include all

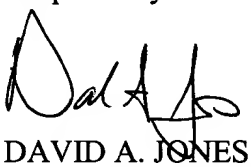
limitations of claim 1, claims 12-14 are also allowable at least due to their dependency on an allowable base claim. Moreover, as discussed above, the combination of *Wang* with *Dobberpuhl* does not disclose, suggest, nor make obvious the limitations of claims 1 or 9. Therefore, the Applicant's respectfully request that the rejection of claims 12-14 under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 1st day of August, 2005.

Respectfully submitted,



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